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U.S. DEPARTMENT OF COMMERCE
PATENT AND TRADEMARK OFFICE

Trademark Trial and Appeal Board

In re Frank H. Robinson & Company, Inc.

Serial No. 74/244,767

David H. Jaffer of Rosenblum, Parish & Isaacs for Frank H.
Robinson & Company, Inc.

Caryn L. Hines, Trademark Examining Attorney, Law Office 108
(David E. Shallant, Managing Attorney).

Before Hohein, Walters and Chapman, Administrative Trademark
Judges.

Opinion by Hohein, Administrative Trademark Judge:

An application has been filed by Frank H. Robinson &
Company, Inc. to register the term "MARKET VALIDATION" as a
service mark for "consulting services in the field of product and
market development and market research" in International Class 35
and "seminars and management training courses in the field of
product and market development and market research" in
International Class 41.¹

¹ Ser. No. 74/244,767, filed on February 10, 1992, which alleges dates
of first use of May 15, 1984 for the services in International Class
35 and dates of first use of March 4, 1988 for the services in
International Class 41. Although registration was originally sought

Registration has been finally refused under Section 23 of the Trademark Act, 15 U.S.C. §1091, on the basis that the term "MARKET VALIDATION" is "so highly descriptive of a marketing approach" as to be generic and, thus, it is not capable of distinguishing applicant's services.

Applicant has appealed. Briefs have been filed,² but an oral hearing was not requested. We affirm the refusal to register.

It is well settled that a term must be capable of serving as an indicator of source in order for it to be registrable on the Supplemental Register. Whether a term has the capacity necessary for registration on the Supplemental Register is determined by considering the meaning thereof as applied to the goods or services, the context in which it is used on any specimens filed with the application, and the likely reaction thereto by the average customer upon encountering the term in the

on the Principal Register, and an amendment to include a claim of acquired distinctiveness pursuant to Section 2(f) of the Trademark Act, 15 U.S.C. §1052(f), was subsequently submitted, applicant thereafter amended the application to seek registration on the Supplemental Register in response to a final refusal on the ground of mere descriptiveness under Section 2(e)(1) of the Trademark Act, 15 U.S.C. §1052(e)(1).

² Although applicant devotes a substantial portion of its initial brief to the contention that the evidence which it has submitted establishes that the term "MARKET VALIDATION" has acquired distinctiveness and that such term is therefore registrable on the Principal Register, the only issue before the Board, in view of the amendment of the application to the Supplemental Register, is whether the term "MARKET VALIDATION" is capable of distinguishing applicant's services. Likewise, the Examining Attorney takes, in part, the same erroneous approach of arguing issues which pertain to registrability on the Principal Register rather than dealing solely with the issue of genericness, which is determinative of whether the term "MARKET VALIDATION" is registrable on the Supplemental Register for applicant's services.

marketplace. See *In re Cosmetic Factory, Inc.*, 208 USPQ 443, 447 (TTAB 1980). "The test is not whether the mark is already distinctive of the applicant's goods [or services], but whether it is capable of becoming so." *In re Bush Brothers & Co.*, 884 F.2d 569, 12 USPQ2d 1058, 1059 (Fed. Cir. 1989), *citing* *In re Simmons Co.*, 278 F.2d 517, 126 USPQ 52, 53 (CCPA 1960). Furthermore, as noted in *H. Marvin Ginn Corp. v. International Association of Fire Chiefs, Inc.*, 728 F.2d 987, 228 USPQ 528, 530 (Fed. Cir. 1986), a generic term is incapable of registration on either the Principal Register or the Supplemental Register.

Moreover, in the case of a term asserted to be incapable because it is generic, the burden is on the Patent and Trademark Office to show the genericness of the term by "clear evidence" thereof. *In re Merrill Lynch, Pierce, Fenner & Smith, Inc.*, 828 F.2d 1567, 4 USPQ2d 1141, 1143 (Fed. Cir. 1987). See also *In re American Fertility Society*, ___ F.3d ___, ___ USPQ2d ___, 1999 U.S. App. LEXIS 19632, No. 98-1540, slip op. at 9 and 13 (Fed. Cir. Aug. 19, 1999). As stated in *American Fertility Society*, *id.* at 12, "[a]ptness is insufficient to prove genericness"; instead, "the correct legal test, as set forth in Marvin Ginn, requires evidence of 'the genus of goods or services at issue' and the understanding by the general public that the mark refers primarily to 'that genus of goods or services.'" Specifically, in *Marvin Ginn*, supra at 530, our principal reviewing court held that:

Determining whether a mark is generic [and thus not capable of distinguishing an applicant's goods or services] ... involves a

two-step inquiry: First, what is the genus of goods or services at issue? Second, is the term sought to be registered ... understood by the relevant public primarily to refer to that genus of goods or services?

In applying such standard, the Board, in *In re Leatherman Tool Group Inc.*, 32 USPQ2d 1443, 1449 (TTAB 1994), noted among other things that "evidence of the relevant public's understanding of a term may be obtained from any competent source, including newspapers, magazines, dictionaries, catalogs and other publications," citing *In re Northland Aluminum Products, Inc.*, 777 F.2d 1566, 227 USPQ 961, 963 (Fed. Cir. 1985).

With respect to the first prong of the genericness test, the Examining Attorney contends that "the class of services at issue are business consultation and educational services relating to issues that arise when new products are introduced." The term "market validation," the Examining Attorney insists, "is a business marketing term" which designates a class of services involving "new product testing". Applicant, on the other hand, maintains that the Examining Attorney has misunderstood and therefore mischaracterized both its "consulting services in the field of product and market development and market research" and its "seminars and management training courses in the field of product and market development and market research". In particular, applicant asserts that (emphasis in original):

Applicant does not engage in product testing for its customers, nor does Applicant advise its customers how to test specific products. Applicant's consulting services relate to educating businesses in [the] use of a control system for addressing issues encountered when companies introduce new or

improved products. Applicant also provides seminars and management training courses in how to use this control system. Thus, Applicant's services do not relate to product testing. Instead, they relate to a system which facilitates a company's management of its introduction of new products.

Specifically, as variously stated in the advertising submitted by applicant as specimens of use (*italics in original*):

Market ValidationSM is a management control system for product and market development. It implements a precise standard of performance for linking developers and marketers directly to customers.

*Market Validation is a management control system It links key business managers directly to customers as an integrated unit to understand: "Is the market real?", What *precisely* does the customer want?", "How large is the market?", and "What must I do to develop and keep it?"*

*Most companies want to understand markets and customers better but lack the necessary performance standard, logistical know-how, and discipline. Frank H. Robinson & Co. is a facilitator and trainer. We start with a high priority project, often a new product. We formulate a team within the company, and work along side it to conclusion of a phase -- *Initial Validation, Design Spec Freeze, Sales Start-Up, Post Intro Assesment, or Sales Expansion*. We then work on another phase or product but with decreased involvement.*

Market Validation is a system of collecting and analyzing information needed for:

- Making *investment* decisions in each phase of product and market development.*
- Making the best possible *operating* decisions in each phase.*
- Trouble shooting *problems* in the latter phases of market development.*

Thus, it would appear that applicant is correct that its services do not involve new product "testing" as such, but rather relate principally to business management of new product development and marketing programs. Accordingly, and because applicant's services, as recited in the application, are very broadly identified, we find that the genus, class or category thereof must be viewed as being the same as those services are set forth in the application, namely, "consulting services in the field of product and market development and market research" and "seminars and management training courses in the field of product and market development and market research".

Turning, therefore, to the second prong of the test for genericness, the Examining Attorney argues that "the relevant public, which is the business community at large, understands the claimed mark to refer to services relating to new product testing" in the sense that the term "market validation" names the process or method of new product development and market research consulting services offered by applicant. Specifically, the Examining Attorney contends that:

The claimed mark "MARKET VALIDATION" is a widely used business term that refers to a gauge used when consumers are introduced to new products. It appears that companies test market products and services to establish their mass market appeal and [that] this process is called "market validation." This marketing term is so descriptive as to be generic and incapable of identifying the applicant's services and distinguishing them from the services of others.

As to applicant's educational services, the Examining Attorney asserts that "because 'market validation' is the kind of business

consultation performed by the applicant and is the marketing subject matter taught in the [applicant's management training courses and] seminars, the proposed mark is so descriptive that it appears to be generic for the services."

The Examining Attorney, in support of her position, relies upon excerpts of articles from the "NEXIS" database, the most pertinent of which are reproduced below, as demonstrating that "the term 'market validation' is a term of art in the business industry" (emphasis added):³

"In filing the proxy statement, CarMax is seeking **market validation** of the used-car superstore concept--and public money to finance its expansion." -- Tire Business, January 20, 1997;

"Dave Orecchio, product marketing director, said: '**Market validation** really matters in this industry and clearly customers are validating Workview Office by choosing it in record numbers.'" -- Electronic News, August 5, 1996;

"... networks engineering at DEC, is to help network operators move from high-speed

³ Although forming part of the record, many of the excerpts are from articles obtained from proprietary news services. Such articles, however, are of little, if any, probative value with respect to genericness issues. This is because, unlike newspaper, magazine and journal articles, wire-service stories are not presumed to have circulated among the general public so as to have had any influence on purchasers' attitudes towards the particular term in question. See, e.g., *In re Appetito Provisions Co. Inc.*, 3 USPQ2d 1553, 1555 (TTAB 1987) at n. 6 and *In re Men's Int'l Professional Tennis Council*, 1 USPQ2d 1917, 1918 (TTAB 1987) at n. 5. Accordingly, no further consideration will be given to such excerpts. Moreover, while the use of a particular term in excerpts from foreign publications does not prove the genericness thereof in the United States, such use nevertheless has some limited probative value to the extent that it may show the term to be generic in other countries for the very same services which applicant provides under such term in the United States. See *In re Consolidated Cigar Corp.*, 13 USPQ2d 1481, 1483 (TTAB 1989). Consequently, we have considered the excerpts from foreign publications for whatever probative value they may provide with respect to the issue of genericness herein.

data trials into deployment by offering **market validation** and cross-vendor integration services." -- Multichannel News, November 27, 1995;

"That means in both instances, shareholders soon will know whether there is **market validation** for the products and whether the companies have the prospect of profits in the future." -- Financial Post (Toronto), July 15, 1995 (article headlined: "Dental-product firms near watershed");

"Treasury officials and White House economic advisers claimed **market validation** of U.S. policy by repeatedly highlighting the bond market as long-term interest rates fell below 7%." -- Bond Buyer, December 27, 1994;

"... by the controls supplier and sent via modem to OEMs, which in turn can be used for data collection, testing, and **market validation** surveys." -- Appliance Manufacturer, December 1994 (article headlined: "Designing electronic controls; Reference Guide: Controls");

"The **market-validation** phase takes about a month. If the proponent demonstrates to the review board that there is a sizable and valid market for the proposed" -- EDN, August 18, 1994 (article headlined: "Hatching a new venture; ESL Inc.'s process of developing commercial products using military electronics technology; Putting Military Technology to Other Uses");

"[Sears] will roll out three specialty catalogs to its customers with Hanover Direct Inc. as the licensee, and six other books are in the '**market validation**' stage" -- DM News, January 17, 1994;

"The growth has made Cheyenne's stock a hot ticket item on Wall Street--its **market validation** is around \$ 450 million, which isn't bad for a company that did \$ 31 million in revenue" -- InforWorld, March 29, 1993;

"... weatherproof gear for commercial fishers and architectural lighting--are

already on sale in America. There is therefore some **market validation** and marketing material already available." -- Herald (Glasgow), February 13, 1993;

"On another level, FTS 2000 is also a form of **market validation** that will help the carriers sell ISDN capacity in the private arena" -- Computerworld Focus, May 4, 1988; and

"Lockheed-Georgia Co. is completing a **market validation** study involving 30 countries prior to making a production decision based on an initial batch of 30 aircraft." -- Aviation Week & Space Technology, February 14, 1977.

The "NEXIS" excerpts, the Examining Attorney insists, "are ample evidence" that the "meaning [which] the business community has ascribed to 'market validation'" is that of "the apt name for new product testing services," irrespective of whether such services are provided by consulting or through seminars and management training courses. The genericness refusal therefore "should be upheld," according to the Examining Attorney.

Applicant, on the other hand, maintains that "[t]he generic terms for Applicant's services are 'consulting services' and 'management training', not 'market validation' services," and urges that the Examining Attorney has failed to present clear evidence that the relevant purchasing public understands the term "MARKET VALIDATION" to refer primarily to the class or category of applicant's services. Specifically, in addition to relying on its submission of several consumer declarations, which the Examining Attorney dismisses as "not persuasive,"⁴ applicant

⁴ Such declarations, although submitted in support of applicant's earlier claim of acquired distinctiveness, nevertheless also have a

asserts with respect to the "NEXIS" evidence of record that "[n]one of the ... stories use MARKET VALIDATION to refer to services related to educating businesses about how to address and manage issues that arise when new products are introduced" (emphasis in original). In particular, as applicant points out in its reply:

In the present case, there is absolutely no evidence that MARKET VALIDATION is generic for Applicant's "consulting services in the field of product and market development and market research ..." or "seminars and management training courses in the field of product and market development and market research ...". While "market validation" may be merely descriptive or even generic for actual product testing, it is neither merely descriptive or generic for Applicant's services, which are directed toward helping companies manage product introduction not toward the introduction of the products themselves.

Upon careful consideration of the entire record, we are constrained to agree with the Examining Attorney that the term "MARKET VALIDATION" has been shown by clear evidence to be a generic term for the field of product and market development and market research in which applicant renders its consulting

bearing on the issue of genericness. In each instance, the declarant recites in substance that:

I am familiar with the Market Validation services of Frank H. Robinson & Company, Inc. We have used the firm's services since ... [a specified period of time]. I have always understood the term Market Validation to refer specifically to the product and market development services of Frank H. Robinson & Company, Inc. as the only source of services performed under the Market Validation service mark.

The Examining Attorney criticizes such declarations as being "from a relatively small number of people who have dealt with the applicant for many years" and for failing to "refer to or identify the [applicant's] services with any specificity".

services and its seminars and management training courses. While the declarations furnished by applicant indicate that the declarants know applicant as the sole source of the particular consulting and educational services which they have received from applicant with respect to product and market development and market research, the pertinent "NEXIS" excerpts clearly show--as applicant essentially acknowledges in its reply--that the field of "product and market development and market research" in which applicant renders its services is generically known by the term "market validation". Consequently, to the relevant purchasing public for services of the kinds provided by applicant, the term "MARKET VALIDATION" would primarily signify only a category, class or type of consulting services and seminars and management training courses.

Stated otherwise, such term generically names the particular kinds of services rendered by applicant in the sense that it designates the specific field in which applicant provides its consulting services and its seminars and management training courses. Businesses interested in managing their new product introductions would readily understand that "MARKET VALIDATION" generically names consulting services, as well as seminars and management training courses, which pertain to the field of product and market development and market research. See, e.g., In re Pennzoil Products Co., 20 USPQ2d 1753, 1758-60 (TTAB 1991) ["MULTI-VIS" for "multiple viscosity motor oil" is generic and incapable of registration]; and In re Wickerware, Inc., 227 USPQ 970, 971 (TTAB 1985) ["WICKERWARE" for "mail order and

distributorship services in the field of wicker furniture and accessories" is generic for "a central characteristic of appellant's services" and thus is incapable of registration]. Accordingly, because the pertinent "NEXIS" excerpts constitute clear evidence that the relevant purchasing public would understand market validation consulting services to be consulting services in the field of product and market development and market research, and would likewise view market validation seminars and training courses as seminars and management training courses in the field of product and market development and market research, the Patent and Trademark Office has met its burden of establishing that the term "MARKET VALIDATION" is generic for applicant's services and thus incapable of registration.

Decision: The refusal under Section 23 is affirmed.

G. D. Hohein

C. E. Walters

B. A. Chapman
Administrative Trademark Judges,
Trademark Trial and Appeal Board